

REMARKS

I. General Remarks

Please consider the application in view of the following remarks. Applicants thank the Examiner for his careful consideration of this application.

II. Disposition of the Claims

Claims 1-68 are pending in this application; claims 69-109 have been cancelled. In this response, claims 1, 4, 5, 14, 15, 17, 25, 28, 29, 37, 38, 39, 41, 47, 50, 51, 54, 60, 61, and 63 have been amended herein to more clearly claim Applicants' invention. All amendments are made in a good faith effort to advance the prosecution on the merits of this case. Applicants reserve their rights to subsequently take up prosecution on the claims as originally filed in this or an appropriate continuing application. Applicants respectfully request that these amendments above be entered and submit that these amendments will put the claims in condition for allowance. Antecedent basis for these amendments can be found throughout the specification.

III. Remarks Regarding Election/Restriction Requirement

During a telephone conference with the Examiner on 4/21/2005, Applicants made a provisional election without traverse to prosecute the invention of Group I, claims 1-68. Affirmation of this election is hereby made. Accordingly, Applicants have cancelled claims 69-109. Applicants reserve the right to pursue these claims as filed in a divisional or other continuing application.

IV. Rejections of the Claims Under 35 U.S.C. §112

Claims 4-5, 28-29, and 50-51 are rejected under 35 U.S.C. § 112, second paragraph, containing "improper MARKUSH groups." (Office Action, p. 2) Although Applicants believe that this language was sufficiently definite to meet the requirements of 35 U.S.C. § 112, Applicants have amended the Markush grouping language in these claims and other claims having the same language per the Examiner's suggestion. Applicants respectfully request that these amendments be entered and submit that these amendments will put these claims in condition for allowance.

V. Rejection of Claims 1, 7-8, 14, 23, 25, 31-32, 38, 47, 53-54, and 60 under 35 U.S.C. § 102(b) as Anticipated by Nimerick

Claims 1, 7-8, 14, 23, 25, 31-32, 38, 47, 53-54 and 60 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,818,991 to Nimerick (hereinafter “Nimerick”). With respect to these claims and Nimerick, the Examiner states that:

Nimerick teaches in column 1, lines 38-59 and column 19, lines 24-33 permeable cement composition comprising a hydraulic cement, water and a degradable material that is injected into a subterranean formation to create a fracture. The reference teaches a polymer as a degradable material. Then the cement composition is allowed to form a proppant in the fracture. Additionally, with regard to claim 1, it would be inherent that voids would be created in the proppant after the degradable material has time to degrade.”

(Office Action, at page 3-4.) Applicants respectfully disagree.

To form a basis for a rejection under 35 U.S.C. § 102(b), a prior art reference must disclose each and every element as set forth in each rejected claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004) (hereinafter “MPEP”). Nimerick does not disclose each and every element as set forth in the rejected claims because Nimerick does not disclose *cement compositions* nor does it disclose degradable materials as that term is used in Applicants’ application. Nimerick also does not disclose forming a set cement proppant matrix within a fracture, *inter alia*, to prop the fracture. Therefore, Nimerick cannot, anticipate Applicants’ claims.

Nimerick is directed to fracturing fluids that comprise a water soluble organic polymer gelling agent and a hydrazine or hydroxylamine breaker. (Nimerick, Abstract; Col. 4, lines 12-41.) The fracturing fluids have an initial relatively high suspending viscosity due to the presence of the gelling agent. (Nimerick, Col. 2, lines 36-46.) The hydrazine or hydroxylamine breakers ultimately reduce the viscosity of the fracturing fluids by degrading the gelling agent polymers. (Nimerick, Col. 4, lines 32-40.) This converts the fracturing fluid to a less viscous fluid having relatively low suspending ability to drop out proppant particulates from the fluid into the formation. (*Id.*) In effect, Nimerick teaches traditional fracturing fluids.

On the other hand, Applicants’ invention is directed to the use of cement compositions that comprise a hydraulic cement, water, and a degradable material in various fracturing operations. These cement compositions set within a fracture to form a proppant matrix therein. The term “proppant matrix” as used in this application refers to a permeable

continuous mass of a set cement composition that is present within a fracture that, *inter alia*, aids in propping the fracture open. These matrices are unlike conventional proppant packs, which are typically a loose pack or collection of individual proppant particulates.

Nimerick in no way teaches the use of cement compositions for fracturing or the use of set cement proppant matrices to prop fractures. Nimerick also does not teach the use of degradable materials in conjunction with cement compositions in fracturing operations, as recited in claims 1, 25, and 47.

Because Nimerick does not teach these essential elements of Applicants' claims, Applicants respectfully assert that Nimerick does not disclose each element of the methods recited in claims 1, 25, and 47. Thus, Nimerick cannot anticipate these claims, and these claims are allowable over Nimerick. Moreover, since "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers," and since the other rejected claims, specifically claims 7-8, 14, 23, 31-32, 38, 53-54 and 60, depend, either directly or indirectly, from independent claims 1, 25, or 47, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

VI. Rejections of the Claims Under 35 U.S.C. § 103

A. Rejection of Claims 2-3, 26-27, and 48-49 under 35 U.S.C. § 103(a) – Nimerick in View of Thompson

Claims 2-3, 26-27, and 48-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nimerick in view of U.S. Patent No. 6,302,209 (hereinafter "Thompson"). With respect to claims 2-3, 26-27, and 48-49, the Examiner states that:

Nimerick discloses the invention as claimed. However, Nimerick does not disclose the use of a surfactant in his permeable cement compositions. Thompson, Sr. et al. teaches in column 21, line 12 – column 22, line 32 the use of surfactants in permeable cement compositions to disperse the degradable material. Additionally, the reference teaches the use of surfactants in the range of 0.1% to 5% by weight. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Nimerick's cement composition by including a surfactant in the given range to disperse the degradable material in the cement composition in view of the teachings of Thompson, Sr. et al. Using surfactant suspension compositions causes accurate additive delivery in oil and gas completion processes.

(Office Action, at pages 4-5.) Applicants respectfully disagree.

In order for a combination of references to form the basis for a rejection under §103(a), the combination of references must teach or suggest all of the elements of the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2143 (2004) (“MPEP”). However, as discussed in Section V above, Nimerick does not teach or suggest the use of cement compositions comprising degradable materials in fracturing applications. Nimerick also does not teach the formation of set cement proppant matrices. Similarly, Thompson does not teach the use of cement compositions comprising degradable materials in fracturing applications. Rather, Thompson teaches surfactant compositions comprising suspensions of solid surfactants, such as alpha olefin sulfonate, in an organic base fluid such as diesel or vegetable oil. (Thompson, Col. 1, lines 14-17.) Therefore, Nimerick in combination with Thompson does not teach every element of claims 2-3, 26-27, and 48-49. Therefore, claims 2-3, 26-27, and 48-49 are patentable over Nimerick in view of Thompson. Accordingly, Applicants respectfully request the withdrawal of these rejections.

B. Rejection of Claims 4-6, 9, 15-16, 19, 24, 28-30, 33, 39-40, 43, 50-52, 55, 61-62, 65 and 68 under 35 U.S.C. § 103(a) – Nimerick in View of McDaniel

Claims 4-6, 9, 15-16, 19, 24, 28-30, 33, 39-40, 43, 50-52, 55, 61-62, 65 and 68 stand rejected as being unpatentable over Nimerick in view of U.S. Patent Applicant Publication No. US 2002/0048676 A1 (hereinafter “McDaniel”).

With respect to claims 4-6, 9, 28-30, 33, and 50-52, and 55, the Examiner states that:

Nimerick teaches the features as claimed except for the use of high aluminum content cement or Portland cement. McDaniel et al. teaches in paragraphs [0078], [0290], and [0296] a cement that comprises high aluminum content cement or Portland cement. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Nimerick’s cement composition by using a high aluminum content cement or Portland cement as the hydraulic cement composition in view of the teachings of McDaniel et al because they accelerate the setting reaction and improve handling of the mix.

(Office Action, at page 5.) Applicants respectfully disagree.

In order for a combination of references to form the basis for a rejection under §103(a), the combination of references must teach or suggest all of the elements of the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2143 (2004) (“MPEP”). However, as discussed in Section V above, Nimerick does not teach or suggest the use of cement

compositions comprising degradable materials in fracturing applications. Nimerick also does not teach the formation of set cement proppant matrices. Similarly, McDaniel does not teach the use of cement compositions comprising degradable materials in fracturing applications, or the formation of set cement proppant matrices. Rather, McDaniel teaches individual low density proppant particulates that are “made of a binder and filler material.” (McDaniel, Abstract.) Therefore, Nimerick in combination with McDaniel does not teach every element of claims 4-6, 9, 28-30, 33, and 50-52, and 55. Therefore, claims 4-6, 9, 28-30, 33, and 50-52, and 55 are patentable over Nimerick in view of McDaniel. Accordingly, Applicants respectfully request the withdrawal of these rejections.

With respect to claims 15-16, 19, 39-40, 43, 61-62, and 65, the Examiner states that:

Nimerick teaches the features as claimed except for the use of polyester and the degradable polymer with the ability to se [sic] a plasticizer as an additive. McDaniel et al teaches on page 18, paragraph [0265] and page 20, paragraphs [0295], [0292], and [0296] the use of polyester as the degradable polymer with the ability to se [sic] a plasticizer as an additive. The reference also teaches the use of the degradable polymer in the amount of 5% to 70%. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Nimerick's invention and use polyester as the degradable polymer and use a plasticizer as an additive in the cement composition in view of the teachings of McDaniel et al. Using these polymers and additives gives the cement mixture the necessary moldability characteristic of this kind of cement, and to improve its mechanical characteristics.

(Office Action, at page 5-6.) Applicants respectfully disagree.

In order for a combination of references to form the basis for a rejection under §103(a), the combination of references must teach or suggest all of the elements of the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2143 (2004) (“MPEP”). However, as discussed in Section V above, Nimerick does not teach or suggest the use of cement compositions comprising degradable materials in fracturing applications. Nimerick also does not teach the formation of set cement proppant matrices. Similarly, McDaniel does not teach the use of cement compositions comprising degradable materials in fracturing applications, or the formation of set cement proppant matrices. Rather, McDaniel teaches individual low density proppant particulates that are “made of a binder and filler material.” (McDaniel, Abstract.)

Therefore, Nimerick in combination with McDaniel does not teach every element of claims 15-16, 19, 39-40, 43, 61-62, and 65. Therefore, claims 15-16, 19, 39-40, 43, 61-62, and 65, are patentable over Nimerick in view of McDaniel. Accordingly, Applicants respectfully request the withdrawal of these rejections.

With respect to claims 24 and 68, the Examiner states that:

Nimerick teaches the features as claimed except for the creation of cement proppant that possess a permeability ranging from about 1 to about 125 darcies. McDaniel et al teaches on page 26, paragraph [0368] the creation of cement proppant that possess a permeability ranging from about 1 to about 125 darcies. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Nimerick's cement composition and use a proppant with the permeability in the specified range for the cement composition in view of the teachings of McDaniel et al.

(Office Action, at page 6.) Applicants respectfully disagree.

In order for a combination of references to form the basis for a rejection under §103(a), the combination of references must teach or suggest all of the elements of the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2143 (2004) ("MPEP"). However, as discussed in Section V above, Nimerick does not teach or suggest the use of cement compositions comprising degradable materials in fracturing applications. Nimerick also does not teach the formation of set cement proppant matrices. Similarly, McDaniel does not teach the use of cement compositions comprising degradable materials in fracturing applications, or the formation of set cement proppant matrices. Rather, McDaniel teaches individual low density proppant particulates that are "made of a binder and filler material." (McDaniel, Abstract.) Therefore, Nimerick in combination with McDaniel does not teach every element of claims 24 and 68. Therefore, claims 24 and 68 are patentable over Nimerick in view of McDaniel. Accordingly, Applicants respectfully request the withdrawal of these rejections.

C. Rejection of Claims 10-11, 18, 34-35, 42, 56-57 and 64 under 35 U.S.C. § 103(a) – Nimerick in View of Erbstoesser

Claims 10-11, 18, 34-35, 42, 56-57 and 64 stand rejected as being unpatentable over Nimerick in view of U.S. Patent No. 4,526,695 (hereinafter "Erbstoesser"). With respect to claims 10-11, 18, 34-35, 42, 56-57, and 64, the Examiner states that:

Nimerick teaches the features as claimed except for the use of poly(D,L-lactide) as the degradable polymer or the use of a fluid

loss additive. Erbstoesser et al teaches in column 3, line 35 – column 6, line 56, used within the ranges listed in the application, in a fracturing fluid also used to propagate the fracture. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Nimerick's cement composition and used a fluid loss additive in a hydraulic cement fracturing fluid and use poly(D,L-lactide) as the degradable polymer in the cement composition in view of the teachings of Erbstoesser et al. Poly(D,L-lactide) is used because it substantially degrades in the presence of water at an elevated temperature in a relatively short period of time. The fluid loss additive minimizes the fluid loss during the treatment to maintain the wedging effect and propagates the fracture.

(Office Action, at page 7.) Applicants respectfully disagree.

In order for a combination of references to form the basis for a rejection under §103(a), the combination of references must teach or suggest all of the elements of the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2143 (2004) (“MPEP”). However, as discussed in Section V above, Nimerick does not teach or suggest the use of cement compositions comprising degradable materials in fracturing applications, or the formation of set cement proppant matrices in fractures. Similarly, Erbstoesser does not teach the use of cement compositions comprising degradable materials in fracturing applications, or the formation of set cement proppant matrices in fractures. Rather, Erbstoesser teaches well bore fluids that have a fluid loss control agent dispersed therein that comprises a polyester polymer. (Erbstoesser, Abstract.) Therefore, Nimerick in combination with Erbstoesser does not teach every element of claims 10-11, 18, 34-35, 42, 56-57 and 64. Therefore, claims 10-11, 18, 34-35, 42, 56-57 and 64 are patentable over Nimerick in view of Erbstoesser. Accordingly, Applicants respectfully request the withdrawal of these rejections.

D. Rejection of Claims 12, 26 and 58 under 35 U.S.C. § 103(a) – Nimerick in View of Metcalf

Claims 12, 26 and 58 stand rejected as being unpatentable over Nimerick in view of U.S. Patent No. 4,210,455 (hereinafter “Metcalf”). With respect to claims 12, 26 and 58, the Examiner states that:

Nimerick teaches the features as claimed except for the method wherein the cement composition is mixed on-the-fly. Metcalf et al teaches in column 2, lines 22-33 the method wherein the cement composition is mixed on-the-fly. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

was made to have modified Nimerick's method and mix the cement composition on-the-fly in view of the teachings of Metcalf et al. This is a desirable method of mixing a cement slurry due to logistics.

(Office Action, at page 7-8.) Applicants respectfully disagree.

In order for a combination of references to form the basis for a rejection under §103(a), the combination of references must teach or suggest all of the elements of the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2143 (2004) ("MPEP"). However, as discussed in Section V above, Nimerick does not teach or suggest the use of cement compositions comprising degradable materials in fracturing applications, or the formation of set cement proppant matrices in fractures. Similarly, Metcalf does not teach the use of cement compositions comprising degradable materials in fracturing applications, or the formation of set cement proppant matrices in fractures. Rather, Metcalf teaches cement retarders that are compatible with polyamine type fluid loss agents and with certain thixotropic cements. (Metcalf, Abstract.) Therefore, Nimerick in combination with Metcalf does not teach any element of claims 12, 26 and 58. Therefore, claims 12, 26 and 58 are patentable over Nimerick in view of Metcalf. Accordingly, Applicants respectfully request the withdrawal of these rejections.

E. Rejection of Claims 13, 37 and 59 under 35 U.S.C. § 103(a) – Nimerick in View of Onan

Claims 13, 37, and 59 stand rejected as being unpatentable over Nimerick in view of U.S. Patent No. 5,696,059 (hereinafter "Onan"). With respect to claims 13, 37, and 59, the Examiner states that:

Nimerick teaches the features as claimed except for the method of forming the cement compositions by mixing the hydraulic cement, any other dry additives, and water to form a pumpable slurry that is transportable. Onan et al teaches in column 6, line 64-column 7, line 1 a method of forming the cement compositions by mixing the hydraulic cement, any other dry additives, and water to form a pumpable slurry. The pumpable slurry is then transported to the wellbore. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Nimerick's method and blend the cement composition and transport the composition to the well site in view of the teachings of Onan et al. This is a common practice when using cement compositions.

(Office Action, at page 7-8.) Applicants respectfully disagree.

In order for a combination of references to form the basis for a rejection under §103(a), the combination of references must teach or suggest all of the elements of the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2143 (2004) (“MPEP”). However, as discussed in Section V above, Nimerick does not teach or suggest the use of cement compositions comprising degradable materials in fracturing applications, or the formation of set cement proppant matrices in fractures. Similarly, Onan does not teach the use of cement compositions comprising degradable materials in fracturing applications, or the formation of set cement proppant matrices in fractures. Rather, Onan teaches foamed cement compositions. (Onan, Abstract.) Therefore, Nimerick in combination with Onan does not teach any element of claims 13, 37, and 59. Therefore, claims 13, 37, and 59, are patentable over Nimerick in view of Onan. Accordingly, Applicants respectfully request the withdrawal of these rejections.

F. Rejection of Claims 20, 44 and 66 under 35 U.S.C. § 103(a) – Nimerick in View of Rickards

Claims 20, 44, and 66 stand rejected as being unpatentable over Nimerick in view of U.S. Patent No. 6,330,916 (hereinafter “Rickards”). With respect to claims 20, 44, and 66, the Examiner states that:

Nimerick teaches the features as claimed except for the use of a degradable material having a rod-like shape. Rickards et al teaches in column 3, lines 10-20 the use of a degradable material having a rod-like shape. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Nimerick’s cement composition by including a degradable material having a rod-like shape in view of the teachings of Rickards et al.

(Office Action, at page 8.) Applicants respectfully disagree.

In order for a combination of references to form the basis for a rejection under §103(a), the combination of references must teach or suggest all of the elements of the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2143 (2004) (“MPEP”). However, as discussed in Section V above, Nimerick does not teach or suggest the use of cement compositions comprising degradable materials in fracturing applications, or the formation of set cement proppant matrices in fractures. Similarly, Rickard does not teach the use of *cement compositions* comprising degradable materials *in fracturing applications*, or the formation of set cement proppant matrices in fractures. Therefore, Nimerick in combination with Rickard does not teach every element of claims 20, 44, and 66. Therefore, claims 20, 44, and 66, are

patentable over Nimerick in view of Rickard. Accordingly, Applicants respectfully request the withdrawal of these rejections.

G. Rejection of Claim 21 under 35 U.S.C. § 103(a) – Nimerick in View of Tjon-Joe-Pin

Claim 21 stands rejected as being unpatentable over Nimerick in view of U.S. Patent No. 5,696,059 (hereinafter “Tjon-Joe-Pin”). With respect to claim 21, the Examiner states that:

Nimerick teaches the features as claimed except for the method of forming a proppant to prevent the closure of the fracture and to form voids in the proppant matrix. Tjon-Joe-Pin et al teaches in column 1, lines 28-38 a method of forming a proppant to prevent the closure of a fracture and to form voids in the proppant matrix. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Nimerick’s cement composition by including a proppant matrix with channel-like voids to reduce the permeability of the proppant in view of the teachings of Tjon-Joe-Pin et al.

(Office Action, at page 9.) Applicants respectfully disagree.

In order for a combination of references to form the basis for a rejection under §103(a), the combination of references must teach or suggest all of the elements of the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2143 (2004) (“MPEP”). However, as discussed in Section V above, Nimerick does not teach or suggest the use of cement compositions comprising degradable materials in fracturing applications, or the formation of set cement proppant matrices in fractures. Similarly, Tjon-Joe-Pin does not teach the use of *cement compositions* comprising degradable materials *in fracturing applications*, or the formation of set cement proppant matrices in fractures. Therefore, Nimerick in combination with Tjon-Joe-Pin does not teach every element of claim 21. Therefore, claim 21 is patentable over Nimerick in view of Tjon-Joe-Pin. Accordingly, Applicants respectfully request the withdrawal of these rejections.

H. Rejection of Claim 46 under 35 U.S.C. § 103(a) – Nimerick in View of Tjon-Joe-Pin Further in View of McDaniel

Claim 46 stands rejected as being unpatentable over Nimerick in view of Tjon-Joe-Pin as applied to claim 21 above and further in view of McDaniel. With respect to claim 46, the Examiner states that:

Nimerick and Tjon-Joe-Pin et al teach the features as claimed except for the creation of cement proppant that possess a permeability ranging from about 1 to about 125 darcies. McDaniel et al teaches on page 26, paragraph [0368] the creation of cement proppant that possess a permeability ranging from about 1 to about 125 darcies. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the combination of Nimerick's and Tjon-Joe-Pin's cement composition and use of proppant with the permeability in the specified range for the cement composition in view of the teachings of McDaniel et al.

(Office Action, at page 9.) Applicants respectfully disagree.

In order for a combination of references to form the basis for a rejection under §103(a), the combination of references must teach or suggest all of the elements of the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2143 (2004) ("MPEP"). However, as discussed in Section V above, Nimerick does not teach or suggest the use of cement compositions comprising degradable materials in fracturing applications, or the formation of set cement proppant matrices in fractures. Similarly, McDaniel does not teach the use of cement compositions comprising degradable materials in fracturing applications, or the formation of set cement proppant matrices in fractures. Moreover, McDaniel is actually directed to low density proppant particulates that are "made of a binder and filler material." (McDaniel, Abstract.) Similarly, Tjon-Joe-Pin does not teach the use of *cement compositions* comprising degradable materials *in fracturing applications*. Therefore, Nimerick in combination with Tjon-Joe-Pin and McDaniel does not teach every element of claim 46. Therefore, claim 46 is patentable over Nimerick in view of Tjon-Joe-Pin and McDaniel. Accordingly, Applicants respectfully request the withdrawal of these rejections.

VII. Allowable Subject Matter

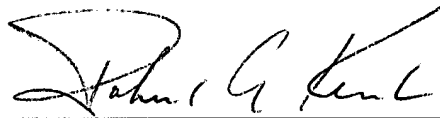
Applicants acknowledge the Examiner's recognition that claims 17, 22, 41, 45, 63 and 67 are drawn to allowable subject matter. The independent claims from which these depend are similarly allowable. Therefore, Applicants have not changed the dependency of these claims.

SUMMARY

Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record below by telephone, facsimile, or electronic mail at the Examiner's convenience.

We believe that no fees are due with this response; however, the Commissioner is authorized to debit any additional fees to Halliburton Energy Services, Inc.'s Deposit Account No. 08-300, Order No. HES 2003-IP-010077U2 for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert A. Kent", is written over a horizontal line.

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